

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 09/429,026

REMARKS

N.B. Applicant notes the Examiner's statement that the "indicated allowability of subject matter in the last Office Action...is withdrawn in view of the newly discovered reference(s)..."; however, Applicant respectfully submits that, in view of this statement, and in view of the fact that the claims were **not** previously amended in a manner to necessitate a search to find the newly cited references, the **finality of the Office Action is premature and should be withdrawn.**

Applicant respectfully traverses the rejection of claims 1, 4, 5, 7, 9 and 12 under 35 U.S.C. § 102(e) as being anticipated by Briffa '411.

A rejection based on anticipation requires that the applied reference disclose, either expressly or inherently, each limitation of each of the rejected claims, or in other words, that each of claims 1, 4, 5, 7, 9 and 12 be readable on Briffa's disclosure. Applicant respectfully submits that clearly such is **not** the case here.

More specifically, Applicant's invention is in the field of predistorting an input signal of an amplifier in order to provide a linear output from the amplifier.

Applicant's claimed improvement, as recited in independent 1, requires:

estimating the instantaneous frequency of each sample of a plurality of samples of an input signal applied to said amplifier, and

applying predistortions to the input signal, said predistortions having values **depending, for each sample, on the estimated frequency of the input signal.**

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Applicant respectfully submits that Briffa fails to disclose, either expressly or inherently, at least the above claim 1 limitation which appears in bold type.

Applicant respectfully submits that the Examiner has misinterpreted Briffa's disclosure in the Examiner's attempt to find readability of these rejected claims on Briffa's disclosure. More specifically, Briffa's "splitter" 34 merely splits an input signal into two physically different paths. Briffa clearly does not disclose, either expressly or inherently, that the applied predistortion is **frequency dependent** as is required by Applicant's independent parent claim 1. In fact, at column 4, lines 61-63, Briffa states, "the predistortion function is generated based on a detected envelope of the input RF signal, thus making the predistortion virtually **independent of the tone frequency**" (emphasis added).

Thus, Applicant respectfully submits that Briffa is **incapable of anticipating** the rejected claims 1, 4, 5, 7, 9 and 12, and also the new **dependent** claims 13, 14 and 15.

The amended independent parent claim 1 is fully supported in Applicant's specification at page 2, lines 5-9. Language deleted from claim 1 is now found in new dependent claim 13.

Applicant also respectfully traverses the rejection of the remaining dependent claims 2, 3, 8, 6, 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable (obvious) over **Briffa's** disclosure in view of the disclosures of Midya '278 or Chiesa '286, and for claims 6, 10 and 11, "further in view of" Ostberg '562. Applicant also respectfully traverses these rejections insofar as they may be applied to the **new dependent** claims 13, 14 and 15.

The deficiencies in Briffa's disclosure have already been described above, whereby, since Briffa does not disclose or suggest all of the elements of the independent parent claim 1, Briffa

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fails as a primary reference in the §103(a) rejections which, thus, are themselves flawed in that they do not provide a *prima facie* showing of obviousness. More specifically, because of the above-noted deficiencies in Briffa's disclosure, the Examiner's proposed modification of Briffa to employ the look-up tables of either Midya or Chiesa fails as a *prima facie* showing of obviousness, since it is clear that the proposed modification would not teach or render obvious the subject matter of each of claims 2, 3 and 8.

For the same reasons, the rejection of claims 6, 10 and 11 under 35 U.S.C. § 103(a) is flawed for not showing *prima facie* obviousness of the subject matter of each of these claims. The deficiencies in the Briffa/Midya or Chiesa combination have been described just above. Because of these deficiencies, the Examiner's proposal to modify Briffa to employ the estimation scheme taught by Ostberg also fails to make out a *prima facie* case of obviousness of the subject matter of claims 6, 10 and 11.

Furthermore, even if, for some reason, someone were to combine the secondary references with Briffa's disclosure as proposed in the two rejections under 35 U.S.C. § 103(a), there would not be produced the subject matter of any of the claims 2, 3, 6, 8, 10, 11 and 13-15.

Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw the rejections under 35 U.S.C. § 102(e) and 103(a), and to find the application to be in condition for allowance with all of claims 1-15. (New dependent claim 13 recaptures language deleted from claim 1. New dependent claim 14 merely recaptures language deleted from claim 10, and claim 15 (15/10) claims a "base transceiver station" including the "transmitter" already defined in claim 10 (10/1).)

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If for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is respectfully requested to **call the undersigned attorney** to discuss any unresolved issues and to expedite the disposition of the application.

REQUEST FOR WITHDRAWAL OF FINALITY OF ACTION

For reasons not understood by Applicant, the Examiner has made "final" the outstanding Office Action (Paper No. 9), even though the Examiner **admits** on page 2 that the Office Action of August 26, 2002 stated that claims 1-12 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, second paragraph. **There were no prior art rejections.**

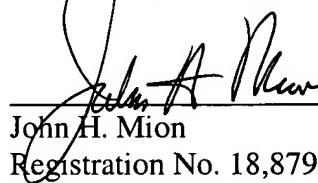
In the Amendment filed January 27, 2003, Applicant amended the claims **only to overcome the 35 U.S.C. § 112, second paragraph, rejection.**

Thus, the previous claim amendments clearly did **not necessitate** (and the Examiner does not even assert that they did necessitate) the citation of "the newly discovered references" (which clearly were available to the Examiner at the time of the Office Action of August 26, 2002) and the issuance of the new prior art rejections based thereon. Therefore, Applicant respectfully requests the Examiner to reconsider and **withdraw the finality** of the outstanding Office Action (Paper No. 9) so that Applicant will have a fair opportunity to amend the claims in response to the prior art rejections based on the **newly discovered** references. (It does not appear that a petition should be required to withdraw the finality, as the questioned "final" Action is clearly premature; therefore, if the Examiner, for some reason, feels that the finality of the Action should not be withdrawn, the Examiner is respectfully requested to **discuss the matter with his supervisor and/or to call the undersigned attorney to discuss the matter.**)

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Applicant files concurrently herewith a Petition (with fee) for an Extension of Time of One Month. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this application, and any required fee for such extension is to be charged to Deposit Account No. 19-4880. The Commissioner is also authorized to charge any additional fees under 37 C.F.R. § 1.16 and/or § 1.17 necessary to keep this application pending in the Patent and Trademark Office or credit any overpayment to said Deposit Account No. 19-4880.

Respectfully submitted,


John H. Mion

Registration No. 18,879

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
(202) 663-7901

WASHINGTON OFFICE

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CUSTOMER NUMBER

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